

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 7 and 11-12 are rejected under 35 U.S.C. 102(e) over the patent to Tsuji.

Claims 5-6 and 13-16 are not rejected over the art.

Also, claims 12 and 13-16 are rejected under 35 U.S.C. 112.

In connection with the Examiner's formal rejections under 35 U.S.C. 112, claims 12, 13 and 15 have been amended as suggested by the Examiner.

Claim 13 has been amended to be responsive. However, it is respectfully submitted that typically three shafts extend from a planetary gear, where either two arbitrary shafts are used as input shafts and the remaining one as an output shaft, or two arbitrary shafts are used as output shafts and the remaining one is used as an input shaft, so that this arrangement can be dynamically shifted. A prior art drawing of a similar

planetary gear is enclosed, and it has been known for decades. Therefore, a special structure does not have to be disclosed.

In view of the Examiner's indication of the allowability of claims 13-16 and the amendments to claims 13 and 15, it is believed that claims 13-16 are now in allowable condition.

Applicant has also canceled claim 5 and submitted a new claim 18 which combines the features of the original claims 1 and 5, and amended claim 6 to depend on claim 18. It is believed that these claims should now be also considered as allowable.

In view of the Examiner's rejection of the claims over the art, applicants have amended claim 1 and submitted another independent claim 17.

It is believed that the new features of the present invention as defined in claims 1 and 17 are not disclosed in the prior art and can not be derived from them as a matter of obviousness.

The patent to Tsujii does not disclose or even suggest the drive arrangement in accordance with the present invention, and also the arrangement disclosed in the patent to Tsujii can not provide for highly advantageous results which are accomplished by the present invention.

The fundamental difference is that Tsujii uses only the sun wheel shaft and the planet wheel carrier shaft to transmit a torque, while the ring gear shaft does not transmit a torque to/from a component external to the planetary gear. The Tsujii's arrangement allows for an operative connection between the ring gear shaft and the planet wheel carrier shaft via the clutch 31. According to column 5, lines 62-64 and column 6, lines 8-10 this arrangement provides a means to toggle between a mode where the rotational force of the motor/generator 3 is transmitted at a decreased speed and a mode where the rotational force of the motor/generator 3 is directly transmitted. In addition to the first clutch 31, the Tsujii's arrangement requires a second clutch 26 (or 28 respectively). This second clutch is also not optional, because in an operating state where the engine has stopped, it is necessary to disengage the engine from the power transmission in order to allow the motor/generator 3 to drive the auxiliary system 9, 14.

In contrast, the drive arrangement in accordance with the present invention uses all three shafts of the planetary gear, wherein each individual shaft is uniquely operatively connected to the either one of the engine, the at least one supplementary motor, or the auxiliary system. More specifically, the sun wheel shaft is connected to the supplementary motor, the planet wheel carrier shaft is connected to the engine, and the ring gear shaft is connected to the auxiliary system. Such an arrangement is not obvious from the teaching of the patent to Tsujii and can not be derived from it. When the drive arrangement is designed in accordance with the present invention, it does not require the clutches of the Tsujii's arrangement, thereby providing a less complex and less expensive to manufacture arrangement. The use of all three planetary gear shafts allows for a dynamic power distribution between the engine, the at least one supplementary motor, and the auxiliary system, as explained in detail on pages 5-7 of the present application.

Claims 1 and 17 define the above mentioned new features of the present invention in general terms, as well as in the specific terms.

It is therefore believed to be clear that the patent to Tsujii does not teach the above mentioned new features of the present invention.

In order to arrive at the applicant's invention from the teaching of this reference, the reference has to be fundamentally modified by introducing into the arrangement disclosed in the reference the new features of the present invention as proposed by the applicants and defined in claims 1 and 17. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the reference does not provide any hint or suggestion for such modifications.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the construction disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish

applicant's results. This was stated by the Patent Office Board of Appeals. In the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 1 and 17 should be considered as patentably distinguishing over the art and should be allowed as well.


As for the dependent claims which depend on claim 1, they share its presumably allowable features, and therefore they should be also allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233